

Appl. No. 09/408,943
Amendment and/or Response
Reply to Office action of 25 February 2004

Page 2 of 5

REMARKS

Claims 1-22 are pending in this application.

The applicant respectfully traverses the issuance of a *final* Office action in this application. The applicant respectfully requests the Examiner's attention to MPEP 706.07(a), wherein it is stated:

"Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection* that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement".

The Examiner has introduced new grounds of rejection in this Office action, to wit, changing the prior rejection under 35 U.S.C. 102(e) to a rejection under 35 U.S.C. 103(a). The applicant respectfully maintains that this change was necessitated by the inadequacy of the basis for a rejection under 35 U.S.C. 102(e), and not by the applicant's amendment. In the applicant's prior response, the applicant noted that the prior art did not teach a method "wherein a request for a content information triggers a transfer of a software element for rendering the requested content information, and effects a compensation to the provider of the software element" (applicant's response of 21 December 2003, page 7, lines 1-3). The applicant respectfully notes that this statement applies equally to both the original and amended claims, and thus the applicant's amendment cannot reasonably be said to have necessitated the Examiner's new grounds for rejection, and thus a final rejection is inappropriate.

The applicant respectfully requests a withdrawal of the finality of the subject Office action.

The Office action rejects claims 1-22 under 35 U.S.C. 101 as being directed to non-statutory subject matter. The applicant respectfully traverses this rejection.

The applicant respectfully maintains that claims 1-22 are within the technical arts and each provide new, useful, concrete, and tangible result, and respectfully requests the Examiner's reconsideration of the rejection of claims 1-22 under 35 U.S.C. 101.

Appl. No. 09/408,943
Amendment and/or Response
Reply to Office action of 25 February 2004

Page 3 of 5

The Examiner's attention is requested to www.uspto.gov/web/menu/pbmethod/aipapaper.rtf, "Successfully Preparing and Prosecuting a Business Method Patent Application", by John J. Love and Wynn W. Coggins, presented at AIPLA Spring 2001:

"VI. COMPLYING WITH 35 U.S.C. 101

35 U.S.C. 101 reads: *"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."* The Supreme Court has stated that Congress intended statutory subject matter to "include anything under the sun that is made by man." *See Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). The Supreme Court has also specifically noted exceptions to this and identified three categories of unpatentable subject matter. They are: "laws of nature, natural phenomena, and abstract ideas." *See Diamond v. Diehr*, 450 U.S. 175, 185 (1981). Further, the Supreme Court has held that mathematical algorithms *per se* are not patentable subject matter to the extent that they are merely abstract ideas. *See Diamond v. Diehr*. In *Diehr*, the Court explained further that certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas *until reduced to some type of practical application*, i.e., "a useful, concrete and tangible result." *See State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02.

Thus, practical application is achieved when the claimed subject matter produces a useful, concrete and tangible result. *This is the test for identifying statutory subject matter* not only in computer-related inventions classified in Class 705, but *throughout the Office*" [bold-italic emphasis added].

The Office action asserts that "the inventive concept in claims 1 and 9 only recite an abstract idea" (Office action, page 3, line 4). The applicant respectfully notes that, consistent with USPTO rules and practices, as cited above, when an invention results in a useful, concrete, and tangible result, it is not "an abstract idea". The applicant further notes that the Office action acknowledges that the recited method does produce a useful, concrete, and tangible result (Office action, page 3, line 9).

The Office action further asserts that the claimed methods are not within the technological arts. The applicant respectfully traverses this assertion, because the claims specifically recite, for example, facilitating (claim 1)/triggering (claim 9) a "transfer of a software element", which is well within the technical arts, regardless of how the transfer is effected.

Appl. No. 09/408,943
Amendment and/or Response
Reply to Office action of 25 February 2004

Page 4 of 5

Because the applicant's claimed methods each provide new, useful, concrete, and tangible results within the technical arts, the applicant respectfully requests the Examiner's reconsideration of the rejection of claims 1-22 under 35 U.S.C. 101.

The Office action rejects claims 1-22 under 35 U.S.C. 103(a) over Jacobs et al. (USPA 2001/0034763, hereinafter Jacobs). The applicant respectfully traverses this rejection.

Claim 1, upon which claims 2-8 depend, specifically recites facilitating a transfer of a software element for rendering content information based on a request for the content information, and effecting compensation to the provider of the software element. Claim 9, upon which claims 10-22 depend, specifically recites triggering a transfer of a software element for rendering content information based on a request for the content information, and compensating the provider of the software element for this transfer.

The Office action cites Jacobs as teaching the concept of having software providers crediting distributors of their products with a percentage of advertisement revenues generated by their software products, and asserts that such a concept is obviously bilateral. The applicant concurs with this characterization of Jacobs, but disagrees that a bilateral compensation arrangement is obvious, and disagrees that a bilateral arrangement of the compensation scheme taught by Jacobs would result in the applicant's invention.

With regard to an "obvious" bilateral agreement, Jacobs effectively teaches providing a royalty arrangement, wherein advertisement profits are distributed to parties that facilitated the generation of the profits. The applicant respectfully maintains that royalty agreements are rarely bilateral.

Assuming, in argument, that a bilateral advertisement royalty agreement as taught by Jacobs were arranged between the software provider and the distributor, as suggested by the Examiner, such a bilateral arrangement would result in the software provider being compensated based on the profits generated by advertisements of the distributor. Such a bilateral arrangement of Jacobs does not correspond to the applicant's claimed invention.


Appl. No. 09/408,943
Amendment and/or Response
Reply to Office action of 25 February 2004

Page 5 of 5

Because Jacobs neither teaches nor suggests providing compensation to a software provider based on requests for content information from a content provider, as specifically claimed in the applicant's independent claims, the applicant respectfully requests the Examiner's reconsideration of the rejection of claims 1-22 under 35 U.S.C. 103(a) over Jacobs.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the present application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Robert M. McDermott, Esq.
Reg. No. 41,508
804-493-0707